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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,849	09/22/2000	Robert M. Berton	426882000400	2900

35452 7590 10/23/2003

ACCENTURE C/O MORRISON & FOERSTER
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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,849

Applicant(s)

BERTON ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 3, 5 - 13 and 15 - 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 3, 5 - 13 and 15 - 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/23/2003 has been entered.

Response to Amendment

The office action of 4/23/2003 rejected claims 1, 10, 13 and 18 - 20 as unpatentable over SiComm in view of AMS. Claims 3, 5 - 7, 9, 11, 12, 15 and 17 were rejected as unpatentable over SiComm in view of AMS and NIC I and II.

Applicant amendment of 9/23/2003 amended claims 1, 4 - 10, 12 - 13, 17 - 18 and 20, which also addressed and thereby overcame the 35 USC 112 rejection. In addition, applicant canceled claims 2 and 14 as well as added new claims 21 - 23.

Currently, claims 1 - 3, 5 - 13 and 15 - 23 are pending.

Response to Arguments

Applicant did not have any arguments of note with respect to the previous Office Action dated 4/23/2003.

Claim Objections

Applicant is advised that should claim 1 be found allowable, claims 5, 12, 13 and 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

Applicant is advised that should claim 3 be found allowable, claims 7 and 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

Applicant is advised that should claim 4 be found allowable, claims 8 and 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

Applicant is advised that should claim 9 be found allowable, claims 10 and 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

When two or more claims in an application are duplicates or else are so close in content that they cover the same thing, despite slight differences in wording, it is proper after allowing one claim to object to the other(s) as being substantially a duplicate of the allowed claim. See MPEP 706.03(K).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 6, 9, 10, 12, 13, 17, 18, 20 and 21 – 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the applicant only had general statements regarding these financial incentives addressed on pages 11 and 12 of the specification, which describe a generic business model incorporating fee sharing.

Claims 1, 5, 6, 9, 10, 12, 13, 17, 18, 20 and 21 – 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter is the method for “sending a second portion of the payment funds to a reserve fund and sending a provider payment from the reserve fund to the services provider” – and additional extensions/variations reflected for example in claim 6.

As result of the new matter introduced, the priority date for the new matter will be consider being 9-23-2003.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 – 3, 5 – 7, 9 – 15 and 17 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over “NIC Launches Industry’s First Comprehensive Suite of eGovernment Solutions For Citizens, Business and Government”; PR Newswire; New York; June 1, 2000 (hereafter referred to as NIC I) and NICUSA web pages captured via the WayBack Machine (hereafter referred to as NIC II) in view of “For State of Washington AMS Buy Plan Made lots of Sense State of Washington awards two-year e-procurement solution contract to American Management Systems”; Washington Technology; page 40; July 3, 2000 (hereafter referred to as “AMS”) and further in view of SiCommNet web pages captured via the WayBackMachine (archieve.org) and here after referred to as “SiComm”.

Regarding claim 1 and related claims 5, 9, 10, 12, 13, 18 and 20 (currently amended), the combination of NIC I and II, AMS and SiComm teach a computer related method and system for funding a state government procurement system comprising the acts of: where NIC I and II teach a. providing an internet-based procurement system by a services provider for use by a state government agency for procurement of goods and services (see at least Page 1, Para 2 and Page 2, Para 3); b. providing an Internet portal for use by the state government agency to communicate electronically with the internet-based procurement system (see at least Page 1, Para 2 and Page 2, Para 3).

Regarding Claim 3 and related claims 7 and 15 (previously amended), NIC I teaches a method comprising an additional act of providing an Internet portal for a customer of the state government agency, whereby the customer can execute an electronic transaction, via the internet-based procurement system, with the state government agency in exchange for a fee, wherein the customer is one of the group consisting of a person seeking a driver's license, a person seeking a vehicle license, a person seeking a voter registration, a person seeking a license to practice professionally in the state, a person seeking a business registration, a person seeking a sales tax certificate, a person seeking a sales permit and a person seeking a generic state identification document (Page 3, Para 4). Moreover and regarding claim 11 (previously amended), NIC I and II teach a system wherein the computerized eProcurement system for a state government agency is provided by a services provider for use by the state government agency for procurement of goods and services, where the computerized eProcurement system is funded by fees comprising payments from participating vendors, payments by investment from the services provider, and payments by transaction fees collected from customers comprising persons seeking services from a state agency through use of the computerized eProcurement system (see at least NIC I – Pages 4, Para 6, Page 5, Para 1 – 5 and NIC II, Pages 1 and 2) and regarding claim 17 (currently amended), NIC I and II teach a method further comprising: sending a development payment from the reserve fund to the services provider for funding development of the internet-based procurement system (see at least NIC I, Page 5). Moreover and regarding claim 21 (new), NIC I teach a method, further comprising: sending a development payment from the reserve

fund to the services provider for funding development of the internet-based procurement system (Page 5, Para 2).

Although it is implicit, NIC I and II does not specifically disclose and teach c. providing an Internet portal for use by a qualified vendor wishing to sell goods and/or services to the state government agency; d. determining payment funds from the state government agency for goods and/or services provided by the vendor; e. sending a first portion of the payment funds to the vendor.

On the other hand, AMS does specifically disclose and teach c. providing an Internet portal for use by a qualified vendor wishing to sell goods and/or services to the state government agency (see at least Page 1, Para 5); d. determining payment funds from the state government agency for goods and/or services provided by the vendor (see at least Page 2, Para 8); e. sending a first portion of the payment funds to the vendor (see at least Page 2, Para 8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of NIC I and II with the method and system of AMS to have enabled a computer related method and system for funding a state government procurement system comprising the acts of: where NIC I and II teach a. providing an internet-based procurement system by a services provider for use by a state government agency for procurement of goods and services; b. providing an

Internet portal for use by the state government agency to communicate electronically with the internet-based procurement system; c. providing an Internet portal for use by a qualified vendor wishing to sell goods and/or services to the state government agency; d. determining payment funds from the state government agency for goods and/or services provided by the vendor; e. sending a first portion of the payment funds to the vendor – in order to provide the capabilities to electronically connect via an internet portal state procurement personnel and vendors. In this manner, the state can be more efficient and thereby cost less, which can be reflected in reduced taxes – as well as improves the potential sales for vendors, while decreasing their cost as well.

The combination of NIC I and II and AMS substantially disclose and teach the applicant's invention.

However and even though it is implicit in both NIC I and II as well as AMS, the combination does not specifically disclose and teach f. sending a second portion of the payment funds to a reserve fund; and g. sending a provider payment from the reserve fund to the services provider.

On the other hand, SiComm does disclose and teach f. sending a second portion of the payment funds to a reserve fund (see at least Page 3, Para 4); and g. sending a provider payment from the reserve fund to the services provider (see at least Page 3, Para 4). Moreover:

regarding Claim 6 (currently amended), SiComm teaches a method further comprising: when an input into the reserve fund exceeds an excess-funding threshold, sending a first portion of a corresponding surplus from the reserve fund to the services provider and sending a second portion of the corresponding surplus to the state government agency; and when an input into the reserve fund falls below an insufficient-funding threshold, carrying out an insufficient-funding revision including at least one of: reducing the first portion of the payment funds that are sent to the vendor and increasing the second portion of the payment funds that are sent to the reserve fund, reducing a scope of service of the internet-based procurement system, and sending a supplemental payment from the state government agency to the reserve fund the vendor (see at least Pages 1 – 3). Please note that SiComm does not specifically disclose reserve fund falls below an insufficient-funding level, carrying out an insufficient-funding level revision including either reducing payment to vendors or reducing scope. SiComm as well as NIC and AMS do disclose and teach providing various methods for government agencies to fund and/or pay for these eProcurement portal's (see at least NIC 1, Page 5 and SiComm Page 3) and these will vary to meet individual state funding profiles. In that regard, these methods were old and well known in government contracting at the timer of the applicant's invention. For example, federal government contracts – as well as state contracts are subjected to the variations in funding profile on yearly basis as priorities change with executive administrations/legislative budgets and that scope and overall milestones can and often have been affected. Moreover, the various forms of

contracts used by state governments as well as Federal Government such as Firm Fixed Price (FFP) or Cost Plus (CP) or Cost Plus Incentive Fee (CPIF) often do have provisions/clauses that address for example - *"FAR 52.232-18 Availability of Funds. As prescribed in 32.705-1(a), insert the following clause: Availability of Funds (Apr 1984). Funds are not presently available for this contract. The Government's obligation under this contract is contingent upon the availability of appropriated funds from which payment for contract purposes can be made. No legal liability on the part of the Government for any payment may arise until funds are made available to the Contracting Officer for this contract and until the Contractor receives notice of such availability, to be confirmed in writing by the Contracting Officer (End of clause) and 52.232-19 Availability of Funds for the Next Fiscal Year - As prescribed in 32.705-1(b), insert the following clause in solicitations and contracts if a one-year indefinite-quantity or requirements contract for services is scope changes. As importantly, these potential scope changes due to funding are recognized and are reflected in the Federal Acquisition Regulation for example such as – "contemplated and the contract (a) is funded by annual appropriations and (b) is to extend beyond the initial fiscal year (see 32.703-2(b)): Availability of Funds for the Next Fiscal Year (Apr 1984) Funds are not presently available for performance under this contract beyond _____. The Government's obligation for performance of this contract beyond that date is contingent upon the availability of appropriated funds from which payment for contract purposes can be made. No legal liability on the part of the Government for any payment may arise for performance under this contract beyond _____, until funds are made available to the*

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Contracting Officer for performance and until the Contractor receives notice of availability, to be confirmed in writing by the Contracting Officer (End of clause)".

Moreover, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of NIC I and II, AMS and SiComm with a contractual agreement, which allows for funding changes and the resulting change to contract scope as well as payment alternatives. Additionally, the combination of NIC I, II, AMS and SiComm disclose and teach methods and payment alternatives for funding and operation of eProcurement portals. In that regard, the applicant's addition of a variation of the overall method taught by the references is given little patentable weight – because these online methods and systems for eProcurement of the applicant's, only address a slight variation of the method already taught by the references including methods for payment(s) such as "reserve fund" (see SiComm Page 3, Para 3 for revenue sharing fund) and as a result is given little patentable weight. Theses variations in the applicant's claims regarding funding and payment approaches/methods are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from NIC I and II as well as AMS and especially SiComm. Thereby, the non-fictional descriptive material contained in the claims represented by the new matter is directed only to an obvious variation in the method already disclosed and taught by the references cited and does not affect either the structure or method/process, which leaves the method and system unchanged. Moreover:

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regarding claim 19 (previously amended), SiComm teaches a system wherein the system for a state government agency is provided by a services provider for use by the state government agency for procurement of goods and services, where the system is funded by fees comprising payments from participating vendors, payments by investment from the services provider, and payments by transaction fees collected from customers comprising persons seeking services from a state agency through use of the computerized eProcurement system (see at least Page 3).

regarding claim 22 (new), SiComm teaches a method, further comprising: when an input into the reserve fund exceeds an excess-funding threshold, sending a first portion of a corresponding surplus from the reserve fund to the services provider and sending a second portion of the corresponding surplus to the state government agency (Page 3, Para 4).

regarding claim 23 (new), SiComm teaches a method, further comprising: when an input into the reserve fund falls below an insufficient-funding threshold, carrying out an insufficient-funding revision including at least one of: reducing the first portion of the payment funds that are sent to the vendor and increasing the second portion of the payment funds that are sent to the reserve fund, reducing a scope of service of the internet-based procurement system, and sending a supplemental payment from the state government agency to the reserve fund (Page 3, Para 4). Please note that SiComm does not specifically recite sending a supplemental payment from the state

government. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include this option and thereby increased the probability of the success of the internet procurement portal.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of NIC I and II with the method and system of AMS to have enabled a computer related method and system for funding a state government procurement system comprising the acts of: f. sending a second portion of the payment funds to a reserve fund; and g. sending a provider payment from the reserve fund to the services provider as well as incorporating various funding and corresponding scope changes for flexibility in order to ensure that all parties are committed and understand that changes can effect the contract. In that regard, the each party will benefit from cost savings as well as potential additional sales. Thereby, the users satisfaction will be increased, which will increase the potential use of the portal and the commensurate enumeration benefits for all.

Claims 4, 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of SiComm, AMS and NIC I and II as applied to claims 1, 6 and 13 above, and further in view of "Auctions Pay Dividends for Gov't"; L.S. Tillet; News release; May 2000, www.internetwk.com; 4pgs (hereafter referred to as Auctions).

The combination of NIC I and II, AMS and SiComm substantially disclose and teach the applicant's invention.

However, the combination of SiComm, AMS and NIC I and II does not specifically disclose and teach wherein the state government agency is able to use the internet-based procurement system to sell by auction or other methods, obsolete or excess inventory held by the state government agency to interested buyers.

On the other hand and regarding claim 4 and related claims 8 and 16, Auction teaches a method wherein the state government agency is able to use the internet-based procurement system to sell by auction or other methods, obsolete or excess inventory held by the state government agency to interested buyers (Page 3, Para 1 and 2).

It would have been obvious to one of ordinary skill in the art to have provided the combination of SiComm, AMS and NIC I and II with the method of Auctions to have provided the capability to use the internet-based procurement system to sell by auction or other methods, obsolete or excess inventory held by the state government agency to interested buyers – and thereby increase the opportunity to reduce inventory cost, gain revenue and thus increase the possibility of decreased taxes, while clearly demonstrating the effectiveness of eGovernment initiatives to taxpayers.

Conclusion

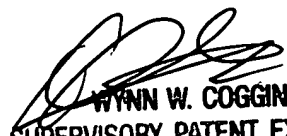
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is Gardner (US 5,758,327), which addresses online procurement/requisitions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 703.308.3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER


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